



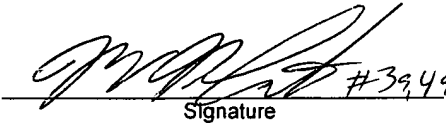
Doc Code: AP.PRE.REQ

PTO/SB/33 (07-05)

Approved for use through xx/xx/200x. OMB 0651-00xx

U.S. Patent and Trademark Office; U.S. DEPARTMENT OF COMMERCE

Under the Paperwork Reduction Act of 1995, no persons are required to respond to a collection of information unless it displays a valid OMB control number.

PRE-APPEAL BRIEF REQUEST FOR REVIEW		Docket Number	
		0905-0241P	
	Application Number	Filed	
	09/612,093-Conf. #7853	July 7, 2000	
	First Named Inventor Yoshiki KAWAOKA et al.		
Art Unit	Examiner		
2625	D. Popovici		
<p>Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.</p> <p>This request is being filed with a notice of appeal.</p> <p>The review is requested for the reason(s) stated on the attached sheet(s). Note: No more than five (5) pages may be provided.</p> <p>I am the</p> <p><input type="checkbox"/> applicant /inventor.</p> <p><input type="checkbox"/> assignee of record of the entire interest. See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed. (Form PTO/SB/96)</p> <p><input type="checkbox"/> attorney or agent of record. Registration number _____</p> <p><input checked="" type="checkbox"/> attorney or agent acting under 37 CFR 1.34. Registration number if acting under 37 CFR 1.34. <u>29,680</u></p> <p> #39,491 Signature</p> <p><u>Michael K. Mutter</u> Typed or printed name</p> <p><u>(703) 205-8000</u> Telephone number</p> <p><u>June 22, 2006</u> Date</p> <p>NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required. Submit multiple forms if more than one signature is required, see below*.</p> <p><input type="checkbox"/> *Total of <u>1</u> forms are submitted.</p>			



Docket No.: 0905-0241P
(PATENT)

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Patent Application of:
Yoshiki KAWAOKA et al.

Application No.: 09/612,093

Confirmation No.: 7853

Filed: July 7, 2000

Art Unit: 2625

For: PRINT ORDER SYSTEM AND METHOD

Examiner: D. Popovici

REQUEST FOR PRE-APPEAL BRIEF CONFERENCE

MS AF
Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Sir:

INTRODUCTORY COMMENTS

Applicants request review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed concurrently with a Notice of Appeal.

The review is being requested for the reasons set forth on the attached sheets.

As detailed below, the Examiner has failed to establish a *prima facie* prior art rejection due to clearly missing teachings from the applied art.

The Examiner Has Failed To Establish Prima Facie Obviousness By Failing To Provide References That Teach Or Suggest All Of The Claim Elements

Claims 3, 22, 25, 28, 31

Claims 3, 22, 25, 28, and 31 are rejected under 35 USC 103(a) as being unpatentable over Cok (USP 6,157,436) in view of Tamura (USP 6,771,896). These claims recite a print order device, which receives a storage medium, reads image data from the storage medium, and transmits the read image data to a print processing device. The claims also recite that the print order device transmits order data including a number of copies to be printed to the print processing device. The claimed print processing device calculates a print end time, which is transmitted to the print order device to be output to the user. The splicer 100 and scanner 102 in Cok are cited to teach the claimed print order device, while Cok's Image Data Manager (IDM) 170 and printer 130 are cited to teach the print processing device. The Tamura patent is relied upon to teach calculating a print end time.

In claims 3, 22, 25, 28, and 31, image *data* is read from the storage medium, indicating that the storage medium is a *data storage device*. Cok's splicer/scanner only receives a filmstrip, which is *not* a data storage device.¹ However, the rejection also cites portions of Cok referring to the media station 111 as receiving a storage medium. However, this media station 111 is *not* part of the splicer 100 or scanner 120 in Cok relied upon by the examiner as the claimed print order device. As shown in Fig. 1 of Cok, the media station 111 cannot not send data to either the splicer 100 or scanner 102. Further, since Cok's media station 111 cannot alone be interpreted as the claimed print order device because it does not transmit order data including a number of print copies as claimed.

During the interview of April 4, 2006, the examiner introduced a modified interpretation of Cok to remedy the above deficiencies, as discussed in page 20 of the Amendment After Final (not entered) filed April 24, 2006 (hereafter "Amendment"). Initially, this modified interpretation represents a *new ground of rejection* and, thus, can only be applied if prosecution of this application is reopened. Further, the claimed invention would still not be obvious in view of this modified interpretation, at least for reasons set forth in pages 20-21 of the Amendment.

At least for the above reasons, the examiner has failed to establish a *prima facie* case of obviousness with respect to claims 3, 22, 25, 28, and 31.

Claims 4, 23, 26, 29, 32

Claims 4, 23, 26, 29, and 32 are rejected under 103(a) as being unpatentable over Cok in view of Farros (USP 5,930,810). These claims recite calculating a print charge, in the print processing device,

¹ See Cok at, e.g., col. 1, line 61 – col. 2, line 27.

according to the image data and order data transmitted from a print order device. The Farros patent is applied to teach this feature.

In Farros, the customer uses a kiosk or personal computer (PC) 110 to select and arrange graphics into a “printed product.” The kiosk/PC 110 of Farros stores a plurality of predefined forms and graphic files from which the customer may choose.² After creating the print product, the customer can print it out himself (using attached local printer 212) or create a print order for a remote facility 120.³ However, even if the print order is to be transmitted to the remote facility 120, Farros’s kiosk/PC 110 *itself* calculates the price of the print order based on pricing information in the form of a plurality of Real-time Pricing Files (RPFs) stored in the kiosk/PC 110, as described in col. 4, lines 37-58. Accordingly, Farros does not teach or suggest calculating the price in another device based on data transmitted from the kiosk/PC 110.

In fact, for the embodiment utilizing a kiosk and remote printing facility, Farros discloses the following:

“An order release procedure is advantageously carried out on the kiosk to ensure *payment* for an order has been made *before the print order is transmitted* to the remote printing facility.”

(Farros at col. 11, lines 12-18; emphasis added). According to the above quote, it is clear that Farros teaches away transmitting the print order from the kiosk before the price is calculated and payment has been made by the customer.

Since the examiner has failed to provide a teaching of a print processing device that calculates a print charge according to image data and order data transmitted from a print order device, a *prima facie* case has not been established with respect to claims 4, 23, 26, 29, and 32.

Claims 5, 24, 27, 30, 33

Claims 5, 24, 27, 30, and 33 are rejected under 103(a) as being unpatentable over Cok in view of Streefkerk (USP 6,058,277) and further in view of Farros. The Streefkerk patent is cited to teach, “changing a print sequence,”⁴ while the Farros patent is applied to teach, “the billing information is sent to the user upon completion of the printing.”⁵

However, these claims recite changing the print sequence when the user accepts a print charge associated with the print sequence change. The examiner fails to point out any teaching in Cok, Streefkerk, or Farros relating to a print charge associated with a print sequence change. Streefkerk contemplates a printing system in an office environment in which a network connects workstations to a

² Farros at col. 4, line 59 – col. 5, line 9; also see Figs. 2 and 3.

³ Farros at col. 5, lines 9-11.

⁴ Office Action of December 22, 2005 (hereafter “Office Action”) at page 6, last paragraph.

⁵ Office Action at page 7, 2nd paragraph, citing col. 4, lines 33-50 of Farros.

plurality of printers.⁶ Based on this environment, it is clear that Streefkerk contemplates changing the print sequence only to *improve office efficiency*, not to extract fees from a customer. Furthermore, Farros does not even teach or suggest allowing the customer to change a print sequence. Thus, neither Streefkerk nor Farros teaches or suggests a print charge associated with a print sequence change, as claimed.

In fact, the examiner does not even assert that any of the applied patents teaches or suggests associating a print charge with a print sequence change. The closest the examiner comes to referring to this claimed element is to assert, "One of ordinary skill in the art could certainly understand that the billing information or cost of the print job would include any additional costs (including a sequence change) associated with the print order."⁷ However, as discussed above, the applied patents do not teach, nor does the examiner assert that they teach, an additional cost associated with a sequence change. Thus, the examiner's statement apparently refers to such a cost in the hypothetical sense (i.e., *if any of the references were to teach an additional cost for a sequence change, it would be obvious to include such cost in the billing information*). However, even assuming *arguendo* the examiner's intent was to assert that an additional cost for a sequence change is well known, this is not sufficient to establish a *prima facie* case of obviousness. As stated in *In re Royka*, 180 USPQ 580 (CCPA 1974), "To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art." As such, the mere assertion that a claim element is "well known," without providing a specific teaching or suggestion in the prior art, is insufficient to establish obviousness.

Since the examiner has failed to point out a teaching or suggestion of a print charge associated with a print sequence change, he has failed to establish a *prima facie* case against claims 5, 24, 27, 30, and 33.

⁶ For example, see the discussion in col. 4, lines 1-17 of Streefkerk, referring to CAD/CAM design workstations, combined scanner/printers, system operators. Also see Figs. 1 and 3 of Streefkerk.

⁷ Office Action at page 7, 2nd paragraph.

Conclusion

In summary, the Examiner has committed clear error on several grounds as detailed above. Therefore, the art rejection should be withdrawn and the case allowed.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 02-2448 for any additional fees required under 37 C.F.R. §§ 1.16 or 1.17; particularly, extension of time fees.

Date: June 22, 2006

Respectfully submitted,

By 

Michael R. Cammarata

Registration No.: 39,491

BIRCH, STEWART, KOLASCH & BIRCH, LLP

8110 Gatehouse Rd

Suite 100 East

P.O. Box 747

Falls Church, Virginia 22040-0747

(703) 205-8000

Attorney for Applicant

MRC/JWR/jm